



MAR 15 2010

Doc Code: AP.PRE.REQ

PTO/SB/33 (07-09)

Approved for use through 07/31/2012. OMB 0651-0031

U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE
Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

PRE-APPEAL BRIEF REQUEST FOR REVIEW		Docket Number (Optional) DGS 001	
I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)] on <u>MARCH 12, 2010</u> Signature <u>Frank McKiel Jr.</u>	Application Number 10/684,312	Filed OCT 10, 2003	
Typed or printed name <u>FRANK MCKIEL JR.</u>	First Named Inventor D.G. SCHNEIDER	Art Unit 3743	Examiner S. GRAVINI
Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.			
This request is being filed with a notice of appeal.			
The review is requested for the reason(s) stated on the attached sheet(s). Note: No more than five (5) pages may be provided.			
I am the			
<input type="checkbox"/> applicant/inventor.			
<input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)			
<input checked="" type="checkbox"/> attorney or agent of record. Registration number <u>43,792</u>			
<input type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34 _____			
Signature <u>Frank McKiel Jr.</u> Typed or printed name			
Telephone number <u>719-482-8464</u>			
Date <u>MARCH 12, 2010</u>			
NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.			
<input type="checkbox"/> *Total of _____ forms are submitted.			

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.



REASONS SUPPORTING PRE-APPEAL BRIEF CONFERENCE

COMBINED REFERENCES FAIL TO MEET ALL RECITED LIMITATIONS

In the recent Final Office Action, dated 11/24/2009, the present Application was rejected under 35 U.S.C. 103 in view of Gilbert (US 5,713,344) in combination with Christen (3,856,374).

At page 5, last full sentence of the Final Office Action, the Examiner's remarks acknowledge that "Gilbert discloses the claimed invention, except for the claimed first side feature and panels available for constructing the first side, along with a plurality of panels."

Applicant compares this acknowledged lacking to the portion of pending independent claim 17 that reads as follows:

"...wherein the first side having user-selectable variable construction is constructed of at least one panel selected by a user from among a plurality of panels available for constructing the first side"

The Examiner then looks to Christen to remedy this lacking, offering very little indication as to how that reference is interpreted to fulfill Applicant's recited limitation as to a plurality of available panels for constructing a single given 'first side'. The remarks by the Office only offer one sentence as follows:

"Christen discloses these features at column 2 lines 30-63 and at column 3 lines 1-11 and shown in figures 1, 5, and 7."

However, none of these cited passages or figures relate to a variably constructed side having at least one panel selected by a user from a plurality of panels available for constructing the given side. Applicant has carefully and thoughtfully reviewed the entire Christen reference and finds that, for each of the sides of the enclosure according to Christen, there is but one way to construct the given side, using only one particular panel provided and always in a fixed configuration. There is never a plurality of panels lending to any variability in construction of a given side. The Office has yet to identify a single side that may vary in construction by a user choosing from among different panels to

assemble the given side.

Applicant's previous arguments to this point are found in the response filed on January 25, 2010, pages 17-18. The Office has not further explained the basis of rejection nor answered Applicant's points as to this apparent lacking in the reference. Accordingly, the Office has not met its *prima facia* burden as to obviousness nor provided sufficient, particular explanation as required by 35 U.S.C. 132.

(NOTE: Some references to Christen on page 3 in the most recent Final Office Action are actually intended to cite Gilbert. The Examiner and Applicant's representative have come to this understanding during previous communications, but the typographical errors remain carried over from previous Actions.)

AFTER-FINAL SHIFT IN EXAMINER POSITION AFFECTS OTHER REJECTIONS

In the recently issued Advisory Action, dated 2/22/10, the Examiner withdraws the 112 rejection relating to Applicant's recitation of "user selectable", further remarking that "the combination of the reconfigurable kit with a variable selection and compacting and stowing parts between uses meets that claim language."

While Applicant is grateful for Examiner's careful reconsideration and withdrawal of the previous 112 rejection, Applicant respectfully submits that this recognition that the invention is adequately described and claimed as a user-reconfigurable kit now urges a reconsideration of the remaining rejections under 35 U.S.C. 103, at least as to claims 17, 18 and 22-24.

In particular, the Examiner has persistently relied upon, in Gilbert, particular skirt panels 36 being attached to a side panel 28 as having user-selectable variable construction. (See Final Office Action of 11/24/09 at pg 3, 2nd para.). As Applicant has argued previously (Response to non-final Action filed 10/5/10), these pieces are permanently welded together in a fixed position at the time of manufacture. (See Gilbert, col 3, line 8.) When the rejection was originally made, the Examiner was broadly considering any variability in arrangement whether at time of manufacture or at time of

use, despite Applicant's insistence that only the latter was claimed. Since that time, as noted above, the Examiner has come to appreciate the 'reconfigurable kit' aspects as being adequately described and particularly claimed.

Now that the Office has given credence to the "user selectable" aspects, aligned with Applicant's contentions that the claimed invention relates to reconfigurability at the time of use rather than at the time of manufacture, the recitation as to "user selectable variable construction" should be given patentable weight. Unfortunately, the outstanding rejections have not been revisited or duly reconsidered in light of this new appreciation for the claimed invention. Gilbert is clearly not reconfigurable in the sense that Applicant has claimed and the Office has now acknowledged.

Applicant respectfully contends that this warrants a fresh reconsideration of the rejections, given the shift in the Examiner's position and the lack of opportunity for Applicant to direct the Examiner to overwhelming shortcomings in the 103 rejections in view of the new acceptance of the "user selectable" recitation as being not only supported by the disclosure, but significantly supportive of Applicant's contended interpretation that differentiates from Gilbert. The interests of both the Applicant and the Office in advancing prosecution of the present Application would be best served by reopening prosecution rather than continuing with Appeal before the Board.

FACTUAL ERRORS IN APPLYING REFERENCES

Most of the Office's remarks in the recent final Office Action, dated 11/24/10, with respect to Gilbert are reproduced *verbatim* from previous Actions (such as the Action dated 8/5/09) with all of the obvious shortcomings that Applicant has identified before. (See Response dated 10/5/09.) These faults include:

- pointing to different sides of the prior art structure to encompass what Applicant has claimed must be present on a single side;
- pointing to an alternative embodiment in Gilbert that has no sides whatsoever, much less a variably constructed side according with Applicant's claims;
- relying upon permanently welded panels as being reconfigurable by an end

user; and

- incorrectly identifying which structures in Gilbert contact or support one another.

The Examiner has yet to effectively rebut any of these crucial points and merely reiterates the language of previous rejections based on Gilbert. These important fallacies prevent the Office from meeting its *prima facia* burden.

Specifically with respect to relying upon permanently welded panels as allegedly being reconfigurable by an end user, see the remarks in the Office Action of 11/24/09 and then see Applicant's earlier arguments from a Response filed 10/5/09 as follows:

Rejected Claim	Examiner's Remarks	Applicant's Remarks
17	pg 3, 2nd and 3rd para.	pgs 9-10
18	pg 3, last 2 lines - pg 4; 1-6	pg 11, 2nd para.
22	pg 4, lines 13-17	pg 14, 2nd para.
23	pg 4, lines 17-21	pgs 14-15

With respect to relying on an embodiment of Gilbert lacking any sides whatsoever, see:

Rejected Claim	Examiner's Remarks	Applicant's Remarks
24	pg 4:21 – 5:4	pg 16, 2nd para.
26	pg 5:9-15	pg 17, 2nd para. thru pg 18:1 st para.
27	pg 5:15-20	pg 18, 2nd para.

With respect to pointing to different sides of the structure of Gilbert in relation to what Applicant has claimed must apply to a single side, see:

Rejected Claim	Examiner's Remarks	Applicant's Remarks
18	pg 3: last 2 lines – pg 4:1-6	pg 11:last 5 lines to pg 12, 1st para.
19	pg 4:7-8	pg 12, 2nd para.
24	pg 4:21 – pg 5:4	pg 16, 1st para.
27	pg 5:15-20	pg 18, 2nd para

With respect to incorrectly identifying structures in Gilbert as contacting or supporting one another, see:

Rejected Claim	Examiner's Remarks	Applicant's Remarks
19	pg 4: 7-8	pg 12, 2nd para. to pg. 13, 1st para.
20	pg 4: 8-12	pg 13, 2nd para.
21	pg 4: 12-13	pg 13, last para. contin. on pg 14.

CONCLUSION

In summary, Applicant contends that the nature and weight of the above mentioned shortcomings in the rejections warrant reopening of prosecution on the merits. Applicant hereby respectfully requests prompt review and thorough consideration of these arguments by the Office.

Respectfully submitted on behalf of Applicant,



Frank McKiel, Jr.
Reg. No. 43,792